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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/544,084
Filing Date: April 06, 2000
Appellant(s): SAEBO ET AL.

Robert A. Goetz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 25, 2007 appealing from the Office action mailed August 25, 2004.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/271,024;

09/132,593;

09/949,458

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

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The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. The double patenting rejection over claim 9-16 of U.S. Patent No. 6,015,833 is herein withdrawn in view of appellants' arguments.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US Patent 5,760,082	Cook et al.	June 2, 1998
US Patent 3,162,658	Baltes et al.	December 22, 1964
WO 97/18320	Cain et al.	May 22, 1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. in view of Cain et al. and Baltes et al.

Cook teaches a food product containing conjugated linoleic acids, their esters, salts or mixtures. The linoleic acid compounds may be from corn oil, safflower etc. the food products

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may further containing vitamins. The conjugated linoleic acid may be in the forms of free acid, non toxic salt or esters, such as triglycerides. See, particularly, the abstract, column 1, lines 10-13, lines 49-60. Column 2, lines 51-67, Examples 2- 5. Cook teaches that employment of alkali catalyst for making conjugated linoleic acid moiety for linoleic acid moiety is known. See, particularly, example 1, in column 2. Cook further teaches that conjugated linoleic acid may be incorporated into various food products. See column 5, lines 6-14.

Cook does not teach expressly to employ alcoholic catalyst for isomerization of linoleic acid to obtain CLA, or to employ antioxidants such as vitamin E in the food products or the conjugated linoleic acid compounds are produced by the method herein, e.g., treating linoleic acid with potassium methylate, or particularly reduce the volatile organic compounds to the level of 5 ppm.

However, Cain et al. teaches that it is well-known in the art that antioxidants, such as vitamin E or BHT, is known to be useful in food product containing conjugated linoleic acid compounds, e.g., conjugated linoleic acid ester. See, particularly, page 6, lines 29-36, the examples 1-20 and the claims. Cook teaches that any solvent in CLA should be removed under vacuum, and CLA is stored in a condition no oxidation would happen (under Argon, in dark and low temperature) before the CLA could be used in food product. See, particularly, column 2, lines 40-47. Baltes teach that isomerization of linoleic acid compounds to conjugated linoleic acid compounds by alcoholate catalysts, such as potassium methylate is well known. See, particularly, the examples 2-4 and the claims. The employment of alkali monohydric alcoholate has advantage that isomerization is possible without using more than stoimetical amounts of alkali metal alcoholate. See column 2, lines 31-35.

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Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, or to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidant in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation.

A person of ordinary skill in the art would have been motivated to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, or to incorporate conjugated linoleic acid derivatives, including esters, as well as antioxidants in a food product, wherein the CLA is free of volatile organic compounds and free of oxidation because alcoholate catalysts, such as potassium methylate, are well-known to be useful for isomerization of linoleic acid to CLA, and CLA is known to be sensitive to oxidation and antioxidant are known to be useful along with conjugated linoleic acid compounds in food products. Regarding the limitation about the method to obtain the conjugated linoleic acid, note a method of making ingredients is not seen to render patentable weight to a method which employs such ingredients, absent evidence to the contrary. This is particularly true if the method of making the ingredients is a well-known process, e.g., employ alkali monohydric alcoholate for making conjugated linoleic acid. A process of making a composition by simply combining or mixing the known ingredients is seen to be within the skill of the artisan. Further, purifying CLA composition by using silica gel (adsorbent) is seen to be obvious since silica gel is well known for purification and separation purpose. Having a limitation of the volatile organic compound (VOC) in food product (whether it is the limitation after storage or before storage) is considered

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an optimization of a result effective parameter, which is considered within the skill of the artisan.

See, In re Boesch and Slaney (CCPA) 204 USPQ 215.

(10) Response to Argument

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching suggestion and motivation are found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. In instant situation, it is a fact that the employment of CLA as food ingredient was known, it is a fact that using alcoholic catalyst for making CLA was also known. The employment of CLA made by alcoholic catalyst for food would have been obvious to one of ordinary skill in the art. There is no need of invoking high level of skill in the art. It is true that Baltes et al. did not teach or suggest the employment of CLA obtained therein for food product. But that is simply because at the time Baltes's invention was made, CLA had not been known as useful in food product. Considering the cited references as a whole, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, and incorporate the obtained CLA into food products.

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In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Particularly, taking the cited references as a whole, the employment of alcoholic catalyst for making CLA herein would have been obvious.

Appellant contends that the examiner fails to consider the claimed invention as a whole, and cites several cases, including *Fromson*, to substantiate the position. The examiner is not convinced. First, the cited cases, *Fromson* in particular, are not suitable for the instant situation. Particularly, in *Fromson*, each and every steps and the materials involved are closely related in terms of time and space, each step would affect the others. It would be impossible to separate the step and materials involved. In the instant situation, the two ingredients involved, CLA and food could be made separately in term of space and time. Method of making one ingredients would not affect the other.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to *Baltes*' teaching, the examiner restates that *Baltes* reference

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does not expressly limited to produce CLA for coating. Note that question under 35 U.S.C. 103 is not merely what references expressly teach, but what they would have suggested to one of ordinary skill in the art at the time the invention was made; all disclosures of prior art, including unpreferred embodiments, must considered. In re Lamberti and Konort (CCPA), 192 USPQ 278. Contrary to applicants' assertion, Baltes state "The invention relates to a process for substantially complete catalytic conversion of compounds of unconjugated polyethenoid acid into compounds of conjugated enthenoid acid." (column 1, lines 13-16). " It will be appreciated from the above that this invention is not limited to the materials, steps, conditions and other details specifically described above and can be carried out with various modification. Thus, it will be understood that the process of this invention is broadly applicable to **any unconjugated polyethenoid acid compounds and products containing them.**" (column 8, lines 20-50, emphasis added). Baltes particularly claims the process for the catalytic isomerization of unconjugated polyethenoid fatty acid compounds to conjugated isomers using alkali metal monohydric alcoholate (see, particularly, claim 10-12). It is true that Baltes et al. did not teach or suggest the employment of CLA obtained therein for food product. But that is simply because at the time Baltes's invention was made, CLA had not been known as useful in food product. Considering the cited references as a whole, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ alcoholate catalyst, such as potassium methylate, for isomerization of linoleic acid to obtain CLA, and incorporate the obtained CLA into food products.

The declaration by Dr. Sæbo filed October 18, 2001 have been fully considered, but is insufficient to overcome the rejection because: the teaching of Baltes et al. is not limited to the

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particular oil disclosed in the examples therein. Baltes teaches a general method for isomerising unconjugated polyethenoid to conjugated polyethenoid. See, column 1, lines 13-16. The starting material may be any unconjugated polyethenoid compounds or products containing them. See column 8, lines 20-68. Further, applicant appears to argue the employment of the reaction mixture to foodstuff, what is actually in the claims are the compounds, i.e., conjugated linoleic esters. (“to provide conjugated linoleic acid esters”, see the claims in instant application). The declaration merely provides applicant’s interpretation of Baltes’ teaching and no objective evidence for rebutting the prima facie case of obviousness. Further, the particular utility of CLA disclosed by Baltes is moot to the rejections based on the combination of cited references.

Appellants’ arguments that amounts volatile organic compounds (VOC) is not a result effective variable for food product have been fully considered, but are not persuasive. If VOC would affect the quality of food products, every effort would have been made to control the amount of VOC in food products. e.g., Cook teaches that any solvent in CLA should be removed under vacuum, before the CLA could be used in food product. See, particularly, column 2, lines 40-47.

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner’s answer are provided herein by appellants.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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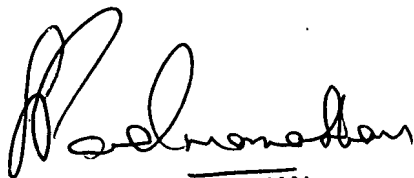


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